

REMARKS

In the Office Action mailed June 7, 2004, the Examiner noted that claims 1-19 were pending and rejected all claims. Claims 1, 2, 8, 9, 13 and 15-19 have been amended, new claims 21 and 22 have been added and, thus, in view of the forgoing claims 1-21 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections and are traversed below.

In the Office Action the Examiner rejected claims 1, 13, 16 and 19 under 35 U.S.C. section 112 paragraph 2 as indefinite. The claims have been amended in consideration of the Examiner's comments and it is submitted they satisfy the requirements of the statute. If additional concerns with the claims arise, the Examiner is invited to telephone to resolve the same. Suggestions by the Examiner are also welcome. Withdrawal of the rejection is requested.

On page 3 of the Office Action, the Examiner rejected claim 19 under 35 U.S.C. § 102(e) as anticipated by Chesnais. Page 4 of the Office Action rejects claims 1-19 under 35 U.S.C. § 103 over Chesnais and Thro.

First, Chesnais is not prior art as the inventors conceived the invention on or before November 27, 2000, which is on or before the effective date (November 30, 2000) of Chesnais as demonstrated by the Declaration attached hereto. Please note that the Declaration is unexecuted, and an executed Declaration will be submitted in due course. For example, claim 1 calls for "creating, by a sender of the message, a priority table of delivery devices of a recipient of the message". The conception of this claim clause is supported by the discussion on page 4 of Declaration Exhibit A with the discussion of the subscriber setting the contents of a priority table. On pages 2 and 5-7 discussing delivery to a telephone, a mobile telephone, a computer by email and a facsimile machine. As another example claim 13 calls for a database and a logic unit and these units are depicted in the figure of page 8. The Examiner is also invited to compare page 8 of Exhibit A with figure 2 of the application. As a further example, claim 19 calls for dynamic changing of the priority table and this is discussed on page 3 with respect to dynamically changing priority based on prior delivery success for the recipient. The Declaration also provides evidence of diligent activities from November 27, 2000 to April 26, 2001 when the above-identified application was filed and therefore constructively reduced to practice.

Withdrawal of the rejection as not being based on an improper prior art foundation is requested.

As noted above, Chesnais is not prior art to the invention. Even if Chesnais were prior art the present invention distinguishes there over for the reasons discussed below.

The present invention is directed to providing a priority table of delivery devices for messages. For example, the delivery of a voice messages might first be tried to a users land line telephone. If the telephone delivery is not successful, then an attempt to deliver the message to a users mobile telephone is made. If this attempt is not successful, then the message could be converted to text and an instant message delivery tried. If this is not successful, a try to send the converted message by email can be made. And so on with other delivery mechanisms or devices such as facsimile, short message service to a handheld device, etc. If all attempts are not successful, the system can recalculate delivery priorities and try to deliver again.

As noted above, the present invention uses priority tables of the priorities for which device to attempt to deliver a message first, second, etc. and then attempts delivery based on the device priority. This is emphasized in the claims (see , for example claim 19 - "receiving priority tables of delivery devices ... selecting, for each message to be transmitted, a delivery device having a highest priority from a corresponding priority table"). The Action, on page 3, points to Chesnais for this feature. The discussion in Chesnais is a discussion of allowing a user to set up a profile that lists devices available for communicating to a subscriber (an availability list). Nowhere in this discussion in Chesnais noted by the Examiner does Chesnais discuss setting a priority order for delivery devices. In fact a word scan of Chesnais will uncover only one use of the word priority, in paragraph [0041] on page 4 and this use is in the context of preserving message information, such as the priority of the message ("message ... priority"). The Examiner is requested to point to any specific instance in Chesnais where the term priority is used in the context of setting a device priority. It is submitted that the present invention distinguishes over Chesnais.

As noted above, the present invention tries different delivery devices until the message is delivered to the recipient. This is emphasized in the claims (see, for example, "continuing ... to sequentially select another delivery device according to the priority table" - claim 1). The Examiner asserts that this trying of additional devices is disclosed in Chesnais by the use of an alternate communication channel in Chesnais at para. 0049. An alternate communication channel does not specify a different communication device. This is demonstrated in Chesnais in paragraph [0031] where a cellular telephone is described as having a voice channel as well as a data (SMS) channel. That is, a single device has multiple channels. It is submitted that

Chesnais does not teach or suggest selecting another delivery device when the message is not received. It is submitted that the present invention distinguishes over Chesnais for this additional reason.

The above-identified application shows in figure 5 a flowchart where when an attempted delivery is not successful (76, 82, 92, 98, 100), the system recalculates 102 the delivery profile and tries again (54 through 76). This loop continues until the message is delivered. A similar sequence is shown in figure 7. This feature is emphasized in the claims (see, for example, "continuing ... until the recipient receives the message" - claim 1). The Action, on page 4, points to Chesnais at para. 0049 for a teaching this feature of "continuing ... until the recipient receives the message" (see claim 1). The action argues that this feature of claim 1 is inherent. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." . . . "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." (See Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991) Paragraph 0049 just says to try to find another channel or place the message in a queue for later delivery if a delivery error occurs. This says nothing about continuing until receipt and in a certain sense teaches away from the invention by not describing what happens if an alternate channel cannot be found or if the queue is full. It is submitted such is not inherent, especially in view of the uncertainties noted above. It is submitted that the present invention distinguishes over Chesnais for this further reason.

As noted above the present invention uses a device priority table shown for different embodiments in figures 3A-3D. The use of a priority table is emphasized in the claims (see, for example, "a priority table of delivery devices of a recipient of the message" - claim 1). The Action, on page 4, acknowledges that Chesnais does not disclose the feature of "a priority table of delivery devices of a recipient of the message" (see claim 1). The action alleges, on page 4, that Thro discloses this in the table of figure 2 having reference #80. This table 80 (see Thro, col. 5, line 55+) is a table of message processing priorities, such that messages of priority (level) 1 go to the answering service while messages of priority 2 go the email box. This is not a table of recipient device priorities where a message to a first recipient goes first to telephone followed by fax, followed by email, etc. while to a second recipient the device order could be reversed. Instead table 80 this is a message priority table indicating the destination of messages with each level of priority. It is submitted that the present invention distinguishes over Chesnais for this reason.

It is submitted that the invention of the independent claims distinguishes over the prior art and withdrawal of the rejection is requested.

The dependent claims depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the prior art. For example, claim 3 calls for "all messages are sent to the recipient using a particular delivery device". This type of table entry is shown in figure 3A. The result is all messages, text, voice, fax, etc. are sent to the same device and any conversion necessary to do so is performed. Chesnais and Thro do not teach or suggest such. It is submitted that the dependent claims are independently patentable over the prior art.

New claims 20 and 21 emphasize the use of a priority table that prioritizes delivery attempts to delivery devices and claim 21 emphasizes the dynamic update of the table. Nothing in the prior art teaches or suggests such. It is submitted that these new claims, which are different and not narrower than prior filed claims distinguishes over the prior art.

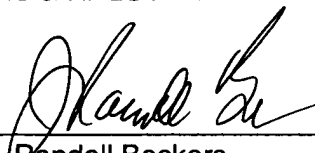
It is submitted that the claims satisfy the requirements of 35 U.S.C. 112. It is further submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

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Date: 11/8/14

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